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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,918	07/15/2003	John W. Sadler	10981415-4	8948

7590 01/15/2004

AGILENT TECHNOLOGIES, INC.
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EXAMINER

ST CYR, DANIEL

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,918

Applicant(s)

SADLER ET AL.

Examiner

Daniel St.Cyr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7/15/03.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The specification of the disclosure is objected to because the continuation applications should include the Patent numbers. Correction is required.

Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 and 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peled et al, US patent No. 5,315,321.

Peled et al disclose a laser scanning apparatus with a position relay mirror comprising: an optical system 10 to generate a light beam and to deliver the light beam to a surface 12; a carrier supporting the surface 12 for reciprocating motion with respect to the light beam to form one axis of a raster; a propulsion system 18 for moving the carrier; a position sensor 22 providing an output signal representing the surface position with respect to the light beam; a servo system 30 responsive to the output signal commanding the propulsion system to move the carrier at a substantially constant speed; and a control system 20 responsive to the output signal to modulate a sample period reciprocally to carrier speed to achieve substantially constant scan length per sample and to control data acquisition timing (see figures 1-2; col. 3, lines 8-57), the position sensor is a LVDT 22, and the propulsion system comprises a rotary servo motor 18, the system

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includes means responsive to the output signal to generate an estimate of carrier speed and means for compensating for variable integral illuminations (see col. 3, line 53 to col. 4, line 24).

Peled et al a motor serving as a propulsion system for moving the carrier, but fail to disclose or fairly suggest a voice coil for moving the carrier. However, the claimed voice coil is functionally equivalent as taught by Peled et al.

It would have been obvious for a person of ordinary skills at the time the invention was made to employ any propulsion device including a voice coil for moving the carrier. Since the voice coil device is functionally equivalent as the disclosed motor by Peled et al and available in the art, it would have been an obvious extension as taught by Peled et al. With respect to some of the specific method steps, such as the specific speed of the carrier, the type of surface, etc., such limitations fall within the engineering design choice. Furthermore, since the structural limitations are as recited, the method steps are obtained, and, therefore, obvious.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,371,370 (hereinafter '370

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Patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat a broader recitation of the '370 Patent. For instance, in claim 1 of the present claimed invention and '370 patent, the applicants claim:

i)"generating a light beam and delivering the beam to a surface . . .", whereas in the '370 Patent the applicants claim "an optical system to generate a light beam and to deliver the beam to a surface . . .";

ii)"detecting a response of the surface to the light beam . . .", whereas in the '370 Patent the applicants claim "a detector for detecting a response of the surface to the light beam . . .";

iii)"moving the light beam and surface with respect to one another at relative speed . . .", whereas in the '370 Patent the applicants claim "a propulsion system for moving the surface. . . reciprocating motion with respect to the light beam. . ."; and

iv)"wherein a voice coil provides the reciprocating", whereas in the '370 Patent the applicants claim "wherein the propulsion system comprises a voice coil"

As to the claims 1-21 of instant application, the '370 Patent meets all the limitation as set forth in claims 1-15.

Thus, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims 1-15 of '370 patent as a general teaching for the scanning function to perform the same function as claimed in the present invention. The instant claims obviously encompass the claimed invention of the '370 patent and differ only in terminology. The extent that the instant claims are broaden and therefore generic to claimed invention of '370 patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a

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generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from the claims in a first patent. *IN re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. & 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. & 1.78(d).

Allowable Subject Matter

6. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, **and upon filing a timely terminal disclaimer.**

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Heninger, US Patent No. 5,128,528, disclose a matrix encoding devices and methods. Garner, US Patent No. 6,160,618, discloses a hyperspectral slide reader. Tanaami et al, US Patent No. 6,494,373, disclose a biochip reader.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

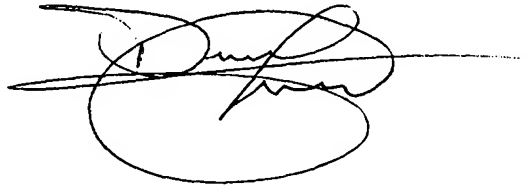
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7721.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr
Primary Examiner
Art Unit 2876

DS
January 8, 2004

A handwritten signature in black ink, appearing to read 'Daniel St.Cyr', with a long horizontal line extending to the right.